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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/820,388 | 03/28/2001 | Paul W. Bennett | 5676-00300 | 7146 |

7590 01/25/2005

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| EXAMINER | |
|---|---|
| CHEN, TE Y | |
| **ART UNIT** | **PAPER NUMBER** |
| 2161 | |

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/820,388 | Applicant(s) BENNETT, PAUL W. | |
|---|---|---|---|
| | Examiner Susan Y Chen | Art Unit 2161 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/02/2004 has been entered.

Claims 1-24 are pending for examination, claims 1, 2, 8 and 15 have been amended, claims 22-24 are newly added.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are rejected under the judicially created doctrine of double patenting over claims 1-42 of U. S. Patent No. 6,742,162 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Systems and methods of a computer-based numerical calculation using a display as a calculator spreadsheet that allows the user to perform the following functions:

a) entering a plurality of numeric values in a one or more columns for vertical calculation, each column having a plurality of fields including operator fields and number fields that are editable;

b) entering a plurality of mathematical operators in a column format of the display screen;

c) automatically calculating the results as the inputted numeric values and mathematical operators entered; and

d) automatically displaying the results on the display screen.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1-24 of the present application merely repeat the features of claims 1-42 of US Patent No. 6,742,162 with fewer limitations. However, it is obvious for an ordinary skilled person in the art at the time the invention was made to remove

limitations from a claim for the purpose to extend a more broader coverage of his/hers invention.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7-9, 11, 14-16, 18, 21-22 and 24, are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (U.S. Patent No. 6,114,977).

As to claims 1-4, 7-9, 11, 14-16, 18, 21, 22 and 24, Smith et al. (Hereinafter referred as Smith) discloses a data processing computer system [Fig. 1] with method and program product [e.g., the KTAPE Software Program, Col. 6, lines 21□60, Fig. 6] to perform direct calculator functions on the fly as claimed by applicant, comprising a CPU [e.g. the Micro-Processor (35), Fig;. 4] coupled with a memory, wherein the memory

stores program instructions [e.g., col. 4, lines 26-38] which are executable by the CPU to:

a) receive user's inputs including numeric characters and a set of operators into memory [e.g., Abstract, lines 6-10; col. 2, lines 20-45; col. 6, lines 32-50];

b) display the values entered vertically by switch input focus to the next field once a mathematical operator being entered [e.g. see Fig(s). 6-9 and associated texts; col. 6, lines 32-61], wherein, the input focus designates a focus field which receives character input from a user until the entering of an equality operator in the second field [e.g., col. 8, lines 38-44];

c) determine and display the intermediate steps of a calculation [Abstract, lines 20-26; col. 6, line 48 - col. 7, line 52];

d) automatically calculate a final result and display it at a the first column below the entered numeric values and mathematical operators [e.g., a final result "46" is displayed below the entered numeric value "12" and the operator "34", Fig. 7].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-6, 10, 12-13, 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent No. 6,114,977) in view of Comer et al. (U.S. Patent No. 6,430,584).

As to claims 10 and 17, although Smith discloses that the on-screen calculation is desired in the accounting and spreadsheets processing [col. 1, lines 9-12] and further discloses that his direct calculator can be activated by other customer-implemented function [e.g., col. 7, lines 49-52], however he did not specifically disclose the details as how to modify one or more inputs.

However, Comer et al. (hereinafter referred as Comer) discloses a programmable computing system with a spreadsheet having on-screen calculator capability which can be configure to perform a user-defined function (UDF). Wherein, the UDF can be a formula that the author writes, a program written in a built-in macro language, or a separate program that interfaces with the spreadsheet. Such that, a user of a programmable computation device can customize the current selected cells of a spreadsheet to perform any user desired functions in the calculation device [Abstract; Fig(s) 1-5; col. 2, lines 15-22; col. 7, lines 31-38]. For example:

a) modifying one or more of the input numeric values in its location on the display [e.g., see the edit option of Fig. 3 in Comer]; or

b) recalculating and redisplay the result of the input numeric values and mathematical operators as modified [e.g., see Abstract liens 13-15; Fig. 5 in Comer].

Smith's and Comer's invention have common subject matter for implementing a computer-based calculator with alphanumeric or graphic capability via software applications, thus, It would have been obvious to one of ordinary skill in the art, at the time the invention was made, with the teachings of Smith and Comer in front of him, being motivated to modify the KTAP Software Program in Smith system with the UDF functions taught by Comer to form a combined system with features as claimed by applicant. Since by doing so, the combined system would allow the end user to edit and recalculate any business computation as desired on the fly.

As to claims 5-6, 12-13 and 19-20, the claimed simultaneous operation is read on by the spreadsheet insert mode.

As to claim 23, except the features recited in claim 22, the combined system of Smith and Comer further discloses the step of entering alphabetical character input in a comment field [e.g., the unit 80, Fig. 5 in Comer; col. 6, lines 47-63].

***Response to Arguments***

Applicant's arguments filed on 08/02/2004 have been fully considered but they are not persuasive.

The examiner disagrees with applicant's arguments that Smith fails to teach or suggest the limitations (as amended) "wherein the first field has input focus," "wherein

the input focus designates a focus field which receives character input from a user" and "automatically switching the input focus to a second field in response to the entering the operator."

In response to applicant's arguments, the examiner points out that Smith clearly disclose the input fields have associated features as claimed by applicant. For example, Smith expressly cited the following:

"The keyboard sends keystrokes representing intermediate steps in a calculation to the computer when in tape mode and keystrokes representing numeric keys when in keyboard mode. The software program runs on the computer and sends a signal from the computer to the keyboard through the communications interface to exit tape mode when the software program becomes inactive, and sends a signal from the computer to the keyboard through the communications interface to enter tape mode when the software program is active. The software program has a display window for display on the monitor. The display window displays, when the software program is active, the intermediate steps of the calculation as the steps are received from the keyboard." [col. 2, lines 32-41]

"When KTAPE is activated and has application focus, it sends a signal from the computer 1 to instruct the keyboard 5 to enter Tape Mode. The signal used in the preferred embodiment is to turn on the Scroll Lock function of the keyboard 5 in a manner known in the art. This signal is received by the processor 35 and the processor places the keyboard in Tape Mode. In Tape Mode, the keyboard 5 operates as in Calc Mode except that intermediate steps of the calculation, including arithmetic functions, are sent to the computer 1, received by the KTAPE application and displayed by it on the monitor 3 in a display window 47 with a portion in a tape 49 format similar to a printer tape of a printing calculator. There is a running total window 51 at the bottom of the display window 47. KTAPE can also be instructed to print the data." [col. 6, lines 32-46]

"Intermediate calculations are sent as a preamble character, a decimal string, an arithmetic operator, a field delimiter, a result string, and a postamble character." [col. 6, lines 48-50].

"Lines of data may be highlighted manually, or the user may accept the lines which have been highlighted automatically as follows. As a line of intermediate data is displayed in a column entry, it is highlighted. Successive lines are also highlighted, until the = operator character is received. When the next line after the = operator is received, all previously highlighted continue to be displayed, but are not highlighted, and the next line is highlighted. If the user desires the previous lines can be manually highlighted."

Based on the above paragraphs, when the KTAPE being activated as shown in Fig. (s) 6-8, the computer-based calculation system switches to an application focus mode, including the input fields such as the numerical value fields of "12", "34", "5" and " 41" and operators fields like "+", "-", and "=", etc, that will receive inputs from an end user of the system as numerical values, operators characters, or highlight and still within the application focus comprising at least input focus and highlight focus. Furthermore, the system will automatically switching the input focus to a second field in response to the entering the operator as shown by the figures 6-8 until the "=" operator is received. As such, in contrary to applicant's arguments, the prior art read the claimed features.

At to the rest of arguments which rehash issues already addressed on record. As such, the instant claims are rejected.

***Conclusion***

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a)Bennett (U.S. Patent No. 6,742,162) which discloses a system and method for computer-based numerical calculation using a calcsheet; and

b) Cragun (U.S. Patent No. 6,813,768) which discloses a system for automatic task focus swapping during browser wait time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

January 6, 2005

UYEN LE
PRIMARY EXAMINER